

## **REMARKS**

### **Claims Rejection Under 35 USC - 103**

Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Thayer et al** (6,131,209) in view of **Beames** (D 466,543).

Thayer et al discloses eyewear comprises solid frames 60 having a lens; said frame 60 consisting of a one piece solid molded frame; said frames having a nose bridge which fits on top of a users nose; said frames secured around a user's head by a single band 52; said band 52 secured to said frames 60 by two securing pieces wherein said band 52 is removed from said frame by either or both of said securing pieces wherein Velcro is used for both securing pieces; wherein said band 52 can be totally removed from said frames and replaced with other similar bands. (see at least figure 5 and the related disclosure.)

Thayer et al teach a single lens in the frame, Thayer et al does not teach that a pair of lenses as that claimed by Applicant.

Eyeglasses have long been designed with the general objective of correction the vision of the eye of the wears. Numerous designs of dual lens glasses and single lens glasses have been developed, differing only in aesthetic feature.

Beames, however, discloses the frames having a pair of lenses. Because Thayer et al and Beames are both from the same field of endeavor, the purpose of aesthetic feature as disclosed by Beames would have been recognized as an art pertinent art of Thayer et al.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the eyeglasses frame, such as the one disclosed by Thayer et al, with a pair of lenses, such as disclosed by Beames for the purpose of aesthetic feature.

In response to applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 f.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, eyeglasses have long been designed with the general objective of correction the vision of the eye of the wears. Numerous designs of dual lens glasses and single lens glasses have been developed, differing only in aesthetic feature. Beames, however, discloses the frames having a pair of lenses. Therefore, at the time of the invention was made to a person having skill in the art to construct the eyeglasses frame, such as the one disclosed by Thayer et al. with a pair of lenses, such as disclosed by Beames for the purpose of the purpose of aesthetic feature. Therefore, the claimed invention does not distinguish over the cited art.

According to the Examiner, it would be obvious to combine any eyeglass patent with any other eyeglass patent since they relate to eyeglasses. This is

not what the MPEP teaches. Again, there must be some teaching, suggestion or motivation to combine the references. All the Examiner is stating is because they are both eyeglasses, that the suggestion to combine the references is there. The MPEP requires that the Examiner point to the teaching, suggestion or motivation stating that both references are for eyeglasses is not a teaching. Further, since Beames does not teach eyeglasses, but teaches sunglasses, which don't correct the vision of the eye of the wearer which is what is stated by the Examiner, there can be no reason to combine Beames with Thayer. Therefore, the claims are allowable in view of Beames over Thayer.

### **Claims Rejection Under 35 USC - 103**

Claims 13-15 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Sadowsky** (5,042,094).

Sadowsky discloses eyewear with prosthetic parts for small children comprises frame (30) for holding two lenses (20), the frame (the frame 30 is constructed with resilient material, preferably also soft and pliable see column 3, lines 21 and 22) secured to a head by a band (40), said band (40) secured to the frames by two securing pieces (42) including Velcro is used for both securing pieces and the band (40) can be totally removed from the frame and replaced with other similar band (see figure 1 and the related disclosure.) Note that solid frame means the frame having the interior completely filled up and free from cavity, or not hollow.

Applicant had previously responded to this rejection and it was removed. The Examiner cannot renew the rejection at this point without new grounds. The Examiner should remove this rejection immediately unless it has other arguments to argue.

Applicant argued that "Amended claim 13 requires that the sunglasses consist of solid frames which consist of a one piece solid molded frame and the frames being secured by a single band. Sadowsky that the frames are pliable and not solid as taught in the amended claims. Further, Sadowsky requires nose and temple pieces for supporting the frame of the baby's face. For these reasons claims 13-15, are not anticipated or obvious over Sadowsky. "This argument is not persuasive because the frame 30 could make by any plastic material (see column 3, lines 24 and 25). Thus, the frame 30 is solid material. Therefore, the claimed invention does not distinguish over Sadowsky device.

Claim 13 requires that the sunglasses have solid frames having lenses. The frames consisting of a one-piece solid molded frame. The frame having a nose bridge and secured around a user's head with a single band. The band secured by two securing pieces. Sadowsky requires nose and temple pieces incorporated into the frame of the device. The device of the present invention does not have any temple pieces. The device of Sadowsky includes prosthetic appendages 34 and 36. Since the language of the claims is "consisting of" and Sadowsky adds extra parts to their glasses which are outside the scope of the claims, the claims must be allowable over Sadowsky.

### **Claims Rejection Under 35 USC - 102**

Claim 13 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Laschober** (4,930,885).

Laschober discloses eyeglasses with resealable headband support arrangement comprises one piece solid molded frame (14) for holding two lenses (16), the frame (14) having a nose bridge (18) with fits on top of the user nose, the frame (14) secured to a head by a band (28), said band (28) secured to the frames by two securing pieces (30), wherein the band (28) is removed from the frame by either or both of the securing means (see figures 1-4 and the related disclosure.)

Applicant had previously responded to this rejection and it was removed. The Examiner cannot renew the rejection at this point without new grounds. The Examiner should remove this rejection immediately unless it has other arguments to argue.

Applicants argued that "Since the claims of the present invention use consisting language, and Laschober requires connector members and attachment members, which are outside the scope of the claims, the claims are not anticipated or obvious. Further, since the claims require that the band is secured directly to the frames, and Laschober requires that the band is secured to the attachment member which is then secured to the connector member, the claims are further not anticipated or obvious over the prior art". This argument is not persuasive because the Laschober device teach every features of the claimed

invention. Laschober discloses eyeglasses with releasable headband support arrangement comprises one piece solid molded frame (14) for holding two lenses (16), the frame (14) having a nose bridge (18) which fits on top of the user nose, the frame (14) secured to a head by a band (28), said band (28) secured to the frames by two securing pieces (30), wherein the band (28) is removed from the frame by either or both of the securing means (see figures 1-4 and the related disclosure). Applicants arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

The Examiner states that because Laschober teaches every feature of the claimed invention that it is prior art. With regards to a "consisting of" claim this goes against the MPEP and case law. The point here is that Laschober teaches other elements which go beyond the elements claimed in the present invention. Because of this, the claims must be allowable over Laschober.

Applicant points to section 2111.03 which relates to transition phrases including "comprising" and "consisting of". This section specifically states that the transition phrase "consisting of" excludes any element, step or ingredient not specified in the claim. Cite *In re Gray*, 53 F.2d 520, 11USPQ 225 (CCPA 1931). *Exparte Davis*, 80 USPQ448 (Bd. App. 1948).

*In Norian Corp. v. Stryker Corp.* Fed. Cir. 2004, the Court held that "consisting of" is a term of patent convention meaning that the claimed invention contains only what is expressly set forth in the claim.

*In Georgia Pacific v. United States Gypsum*, 195 F.3d 1322 Fed. Cir. 1999. The Court described the MPEP as explaining the difference between "comprised" and "consists" as follows.

The transitional term "comprising"...is inclusive or open-ended and does not exclude additional, unrecited elements or method steps.

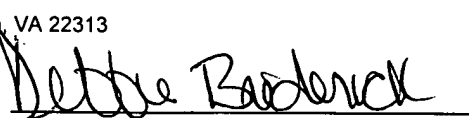
The transitional phrase "consisting of" excludes any element step, or ingredient not specified in the claim.

Based on the MPEP and the case law cited above, because Laschober cannot make obvious the claims of the present invention.

Applicant believes the application is in condition for allowance.


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